

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 11, 2006. At the time of the Office Action, Claims 1-17 were pending in this Application. Claims 10-17 were previously withdrawn due to an election/restriction requirement. Claims 1-9 were rejected. Claim 1 has been cancelled. Claims 2-9 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1-9 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The claims are hereby amended to overcome these rejections.

Rejections under 35 U.S.C. § 102

Claims 1-2, 4-5, and 8 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 57-149085 filed by Oki ("Oki"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

The rejection is moot in view of claim 1 being cancelled without prejudice.

Rejections under 35 U.S.C. §103

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oki in view of Soviet Union Patent No. SU1031652 filed by Slysh et al. ("Slysh"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 6-7 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oki in view of PCT Publication Number WO 00/08353 filed by Frank et al. ("Frank"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which

Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Regarding claim 3, the claim recites "providing a thin-walled seamless drawn steel tube, with a plurality of regularly disposed oblong cutouts by means of beam/jet cutting, wherein *during beam/jet cutting a filler is inserted in the hollow body.*" (emphasis added). It is correctly noted that the specification teaches that "[a] first embodiment of the method according to the invention provides that, by using a suitable filler inside the hollow cylinder during beam/jet cutting, a defined shaping of the beam/jet outlet edge is achieved and damage to the opposite side is prevented." (See Specification at 0017).

It is noted in the rejection that Oki "does not disclose that a filler is inserted in the hollow body during the beam/jet cutting." (See OA at 4). A premise of the rejection is that "Slysch discloses a method for cutting thin-wall tubular stock, which incorporates a spring-loaded supporting mandrel to prevent impact distortions." (See OA at 5). However, this premise fails to establish a *prima facie* case of obviousness. As shown in Figure 1 of Slysh, the blades 1 and 2 are "semi-circular" "sickle-shaped guillotine blades" (See Slysh, title and abstract). These semi-circular guillotine blades 1 and 2 are oppositely positioned so as to squeeze the thin-wall tubular stock between the blades for cutting the entire circumference of the tubing. Slysch actually teaches that "on the downward stroke of the blade (1), both blades penetrate the tube walling, the internal flexible plug (11) of the mandrel preventing tube wall

distortion and the blunting of the semi-circular blades.” (*See* Slysh, last paragraph of Basic-Abstract). Slysch does not teach beam/jet cutting, nor does it teach or suggest the use of a suitable filler inside the hollow cylinder during beam/jet cutting. According to a beam/jet cutting operation of the present invention, a defined shaping of the beam/jet outlet edge is achieved and damage to the opposite side is prevented. Neither Oki nor Slysch address problems associated with shaping the outlet edge of a beam/jet cutting or the prevention of damage to an opposite side of tubing during a beam/jet cutting. Thus, the rejection fails because Oki and Slysh fail to teach or suggest that “during beam/jet cutting a filler is inserted in the hollow body” as claimed in claim 3.

Claims 2 and 4-9 depend from claim 3. The invention as claimed in these dependent claims is patentable for the reasons noted relative to claim 3.

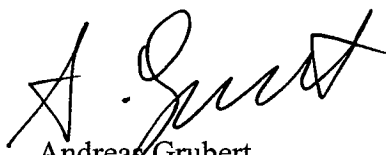
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney, R. William Beard, Jr., at 512.322.2690.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants

A handwritten signature in black ink, appearing to read 'A. Grubert', is written over the printed name.

Andreas Grubert
Ltd. Recog. No. L0225
Limited Recognition under 37 C.F.R. §11.9(b)

Date: April 10, 2006

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